UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte STEPHEN L. GORDON, pro se

Appeal No. 2005-2422
Application No. 09/760,905

ON BRIEF

Before HAIRSTON, KRASS and JERRY SMITH, Administrative Patent Judges.

HAIRSTON, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 1 through 23.

The disclosed invention relates to a system and method for providing a report related to an ergonomics resource to a remote computer via an interactive web-site.

Claim 1 is illustrative of the claimed invention, and it reads as follows:

1. An ergonomics resource system comprising:

an interactive web-site including certain ergonomics resources, said resources including at least one ergonomics program that includes, in turn, at least one database;

a computer remote from said web-site;

access means for interactively connecting said web-site and said remote computer; and,

means to provide at least one report related to said ergonomics resources.

The reference relied on by the examiner is:

Stern et al. (Stern)	6,592,223	Jul. 15, 2003 (filed Oct. 6, 2000)

Claims 10, 11, 16, 17 and 20 stand rejected under the second paragraph of 35 U.S.C. § 112 for indefiniteness.

Claims 1 through 23 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Stern.

Claims 11 and 17 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Stern.

Reference is made to the briefs and the answer for the respective positions of the appellant and the examiner.

OPINION

We have carefully considered the entire record before us, and we will sustain the indefiniteness rejection of claims 11 and 17, reverse the indefiniteness rejection of claims 10, 16 and 20, sustain the anticipation rejection of claims 1 through 23 and sustain the obviousness rejection of claims 11 and 17.

Turning first as we must to the indefiniteness rejection, our analysis begins with a determination of whether the claims do, in fact, set out and circumscribe a particular area with a reasonable degree of precision and particularity when read in light of the application disclosure as they would be by one possessing ordinary skill in the art. In re Moore, 439 F.2d 1232, 1235, 169 USPQ 236, 238 (CCPA 1971).

The examiner's finding (answer, page 4) that claims 10, 16 and 20 are indefinite because they recite intended use statements per se lacks merit. Such expressions may be used in claims, and they are judged for definiteness under the second paragraph of 35 U.S.C. § 112 like any other claimed expression. The examiner's analysis and explanation of In re Casey[1], 370 F.2d 576, 580, 152 USPQ 235, 238 (CCPA 1967) applies to a prior art

[1] A statement of intended use does not serve to distinguish structure over the prior art.

rejection, and not to an indefiniteness rejection. Thus, the indefiniteness rejection of claims 10, 16 and 20 is reversed.

Turning next to the indefiniteness rejection of claims 11 and 17, the metes and bounds of ergonomics programs that "conform to government regulations" would not be understood by the skilled artisan because such regulations are subject to change over time. The appellant acknowledges (specification, page 11) that "the regulations may be modified." A claim cannot be definite when it has different meanings at different times. Consequently, the indefiniteness rejection is sustained because claims 11 and 17 fail to provide definite direction to the skilled artisan trying to determine the scope of the claimed invention.

Turning to the anticipation rejection of claims 1 through 23, we agree with the examiner's findings (answer, pages 4 through 13) that Stern discloses (Figure 3; columns 5 and 6) all of the claimed subject matter. Appellant's arguments (brief, pages 14 and 15) to the contrary notwithstanding, nothing in the claims on appeal (claims 1 through 23) requires that an ergonomics program must have six elements. Features that are

found only in appellant's specification will not be read into the claims. In re Prater, 415 F.2d 1393, 1405, 162 USPQ 541, 551 (CCPA 1969).

Since OSHA and other workplace regulations apply to workplace lighting and use of office equipment to avoid eyestrain, we find that the government ergonomics regulations that apply to appellant's disclosed and claimed invention (claims 11 and 17) equally apply to the ergonomics resource system described in Stern.

Using circular reasoning, appellant argues (brief, page 16) that Stern does not disclose an expert system (claims 2, 5, 10, 16 and 20). We find that Stern discloses an expert system (Figure 3) that dispenses advice that an optometrist would normally dispense, and that such ergonomics advice is understandable by laymen (i.e., the computer user).

Appellant's argument (brief, page 16) that the web site in Stern does not ask the user certain questions is without merit in that the system and method disclosed by Stern has to ask at least background questions to get the program started for each individual computer user (claims 3, 19 and 22). Based upon the

complexity of the interactive system disclosed by Stern, more than one program must be devoted to running such an interactive system (brief, page 16).

Inasmuch as the system in Stern can go to other databases at any time to gather data, appellant's argument (brief, pages 14 and 16) concerning Stern's lack of access of other databases in and out of the system (claim 8, 18, 21 and 22) is without merit.

In view of the foregoing, the anticipation rejection of claims 1 through 23 is sustained.

The obviousness rejection of claims 11 and 17 is sustained because anticipation is the epitome of obviousness. In re Pearson, 494 F.2d 1399, 1402, 181 USPQ 641, 644 (CCPA 1974).

DECISION

The decision of the examiner rejecting claims 10, 11, 16, 17 and 20 under the second paragraph of 35 U.S.C. § 112 is affirmed as to claims 11 and 17, and is reversed as to claims 10, 16 and 20. The decision of the examiner rejecting claims 1 through 23 under 35 U.S.C. § 102(e) is affirmed, and the decision of the examiner rejecting claims 11 and 17 under 35 U.S.C. § 103(a) is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136 (a)(1)(iv).

AFFIRMED

KENNETH W. HAIRSTON)
Administrative Patent Judge)
)
)
)
) BOARD OF PATENT
ERROL A. KRASS) APPEALS AND
Administrative Patent Judge) INTERFERENCES
)
)
)
JERRY SMITH)
Administrative Patent Judge)

KWH:hh

Appeal No. 2005-2422
Application No. 09/760,905

STEPHEN L. GORDON
505 GARDEN VIEW WAY
ROCKVILLE, MD 20850